IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, A. D. 1943.

NO. _____

MEAD JOHNSON & COMPANY,
Petitioner,

vs.

HILLMAN'S, INC.,
Respondent.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

The Opinions of the Courts Below.

The opinion of the District Court of the United States for the Northern District of Illinois, Eastern Division, was filed September 4, 1942. It was not officially reported, but may be found in 55 U. S. P. Q. 6, and appears in the record at page 426 *et seq.*

The opinion of the Circuit Court of Appeals for the Seventh Circuit was filed May 21, 1943. It is reported in Fed. (2d) , and in 57 U. S. P. Q. 448; and it appears in the record at page 478, *et seq.*

Jurisdiction.

(Note corresponding section in the Petition for Writ of Certiorari, *supra,* Page 2.)

Statement of the Case.

Johnson *et al.* devised a new food product for infants, a dry, pre-cooked cereal in such form and having such characteristics that, when mixed with milk or water of any temperature, it instantly reconstitutes into a true mush or porridge having the taste, appearance, and characteristics of a cereal which has been thoroughly cooked in a double boiler for a long period, and with the ability to hold in stable suspension a very high ratio of liquid. Patent No. 1,990,329[5] thereon issued to Mead Johnson & Company, petitioner here, containing claims to such product and to one process for making it. Only the two product claims[6] are in issue here. Mead Johnson & Company manufactures and sells the patented product under the trade-mark "Pablum."

This suit for infringement was brought against Hillman's, Inc., a retail store in Chicago, Illinois, by reason of its sale of Gerber's Cereal Food and Gerber's Strained Oatmeal, dry, pre-cooked infant's cereals manufactured by Gerber Products Company, of Fremont, Michigan. The accused cereals, like petitioner's Pablum, are small, shiny, fragile, porous flakes having all of the characteristics set forth in the product claims in suit. As a result, they have the patented product's ability to instantly reconstitute into a true mush upon the addition of liquid of any temperature, and to hold a high ratio of liquid in stable suspension.

In addition to its great convenience of preparation and high digestibility, the patented product has a very impor-

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[5] Rec. 443.

[6] Claims 5 and 6 of *Johnson et al.* Patent 1,990,329, Rec. 445.

tant advantage as an infant's food in that it is capable of absorbing and holding in a stable suspension 12 or more times[7] its own weight of liquid. This is to be contrasted with the fact that cereal foods such as Zwieback and Holland Rusk, which may be crumbled with milk or water to make a soft food for babies, will hold only three and five times[8] their weight of liquid in stable suspension, respectively. The physical characteristics of the patented cereal flakes is of importance in this regard since, when the patented product is ground to a flour, it will only hold in stable suspension about 8 times its own weight in liquid; i.e., these particular patented flakes unexpectedly absorb a great deal more liquid than the same product in a finely ground state.

This unexpected and unobvious ability to hold in stable suspension a large quantity of liquid is particularly important in feeding infants troubled with a common difficulty known as pylora spasm. Babies having this condition vomit up free liquid, and are unable to retain and assimilate it, but they can and do retain suspensions or mushes in their stomachs, and absorb both the food and the liquid therefrom.[9]

The high ratio of liquid absorption is important because a very young infant needs a high proportion of liquid (an 11 pound baby should receive 32 ounces of liquid per day). Since 2½ ounces of the dry patented product will hold 32 ounces of liquid in stable suspension, a baby troubled with pylora spasm can retain its necessary daily quantity of liquid in a mush formed with that amount of cereal, a large amount for an infant only a few months old,[10] but within its digestive capacity. To provide a stable suspension of the requisite amount of liquid by the use of

7 Rec. 332.
8 Rec. 332.
9 Rec. 297.
10 Rec. 296.

Zwieback, for example, would require 10 or 11 ounces, an impossible quantity for a two or three months old infant.

The claims in suit clearly and definitely define (in terms of some 7 or 8 physical characteristics) the dry, precooked cereal which has this unexpected and highly important advantage as an infant's food. This advantage or function, however, is not stated in the claims.

Specification of Errors.

The errors which petitioner will urge, if the Writ of Certiorari is issued, are that the Circuit Court of Appeals for the Seventh Circuit erred:

(1) In disregarding the advantage, in an infant's food, of a very high liquid absorption ratio, and the unobviousness of the flake product having a higher liquid absorption than a flour made from such product, on the basis of the erroneous rule of law that an advantage of a product not stated in the claims is to be disregarded.

(2) In giving anticipatory effect to an undescribed intermediate product in a prior art process patent, the process of which was never followed in the United States and lay unused for more than a quarter of a century.

(3) In failing to give effect to the long felt want for a product of the kind described and claimed in the Johnson *et al.* patent, and the immediate and widespread public acceptance of the patented product.

(4) In holding the Johnson *et al.* patent in suit noninventive over the prior art.

Argument.

The Seventh Circuit Court of Appeals has erred here in an important proposition of patent law. This Honorable Court, in the Diamond Rubber case,[11] gave effect and weight to an unobvious and highly important advantage not described in the specification or claims of the patent in suit, and held the patent valid.

Now the Seventh Circuit Court of Appeals, in its opinion in this case, has announced the opposite rule of law, that an advantage not mentioned in the claims is to be disregarded. This is in conflict with the Diamond Rubber case; and presents a conflict between the law as now laid down by the Seventh Circuit Court of Appeals and by other Courts of Appeal, as the First,[12] Third[13] and Sixth[14].

One of the very important advantages as an infant's food, stressed by plaintiff, was the very high ratio of liquid absorption of the patented cereal product; and the unobviousness that it would have such a high ratio at all, and particularly that it would have a ratio nearly double that of a flour made from the same product.

The Court of Appeals recognized this to be an important factor in an infant's food, saying:[15]

> "From the record we learn that ease and rapidity in the digestion of a cereal food and the ability of the food to hold a large ratio of water in suspension are important factors where the food does not stay in the digestive tract as long as normally because of some upset condition; * * *"

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11 *Diamond Rubber Co.* v. *Consolidated Tire Co.* (1911), 220 U. S. 428, 436, 437.

12 *I. T. S. Rubber Co.* v. *Panther Rubber Mfg. Co.* (C. C. A. 1, 1919), 260 F. 934, 937.

13 *Gear* v. *Fairmount Electric Co.* (C. C. A. 3, 1916), 231 F. 728, 732; *Mead-Morrison Mfg. Co.* v. *Exeter Mach. Works* (C. C. A. 3, 1915), 225 F. 489, 496.

14 *Jackson Fence Co.* v. *Peerless Wire Fence Co.* (C. C. A. 6, 1915), 228 F. 691, 696.

15 Rec. 479.

Yet the Court of Appeals completely disregarded and gave no weight to this important and unexpected advantage because *it was not functionally stated in the claims.* Defendant, in its brief and argument in the Court of Appeals, urged the proposition that an advantage not set forth in the claims must be ignored in determining the question of invention; and the Seventh Circuit Court of Appeals erroneously accepted this proposition of law, its opinion disposing of this advantage by saying:[16]

> "Plaintiff also contends that an unobvious advantage of 'Pablum' is its ability to hold a very high ratio of liquid in suspension, about twelve times its own weight in liquid. *It will be enough to say that the claims make no mention of this property.*"

The law is clear that claims define a composition properly by defining its *physical characteristics* (as is done here). *It is enough that a new and important advantage results from such combination of characteristics. Such advantage need not be stated in the claims. All that is necessary is that the claims define a composition which is new and different from anything in the prior art, and that the composition defined has the advantage relied on as an improvement in the art.*

In the case of *Diamond Rubber Co.* v. *Consolidated Rubber Co.* (1911), 200 U. S. 428, 55 L. Ed. 527, the opinion of Mr. Justice McKenna specifically recognized the fact that the tipping capacity of the Grant patented tire was its important advance over the prior art, although this advantage was not mentioned in the specification or claims of the patent. This Court upheld the validity of the Grant patent, giving weight to the tipping function, so that it is settled law that an advantage need not be mentioned in the specification or claims of a patent as long as the structure or

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16 Rec. ....

composition is properly defined, and has the desired advantage. Mr. Justice McKenna said (220 U. S. 436, 437):

> "He must, indeed, make such disclosure and description of his invention that it may be put into practice. In this he must be clear. * * * This satisfies the law, which only requires as a condition of its protection that the world be given something new and that the world be taught how to use it. * * *
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> To take from him the advantage of it upon nice speculation as to whether it was an ignorant guess or confident knowledge and adaptation might do him great injustice. His success is his title to consideration."

This rule has been followed, and the law in this regard expressly stated, in cases in the First, Third and Sixth Circuits.

The rule of law has been stated by Judge Bingham for the First Circuit Court of Appeals in *I. T. S. Rubber Co.* v. *Panther Rubber Mfg. Co.* (C. C. A. 1, 1919), 260 F. 934, 937, where he said:

> "The patent is for a structure, and the plaintiff is entitled to the benefit of all the advantages which it possesses over the prior structures intended to accomplish a similar purpose; and the patentee's failure to state in the patent the new mode of operation which his device in fact contains, and which produces a new and beneficial result, does not prohibit the court from taking these merits into consideration in determining the scope of the invention or the validity of the patent."

The rule has been set forth in the Third Circuit Court of Appeals in at least two cases, *Mead-Morrison Mfg. Co.* v. *Exeter Mach. Works*, (C. C. A. 3, 1915), 225 F. 489, 496; and *Gear* v. *Fairmount Electric Co.*, (C. C. A. 3, 1916), 231 F. 728, 732, where Justice McPherson said:

"It is true that the specification and the claims do not refer to all the advantages that seem to accompany the device, but this is not material. If a specification or a claim be sufficient in itself, it need not be all-embracing. It will still be good as far as it goes; and, if it does not go as far as it might have gone, that is the inventor's affair. The evidence before us seems to prove satisfactorily that one advantage of the Williams Device is the facility it affords for narrowing the area of search whenever 'trouble' occurs in an electric circuit; and another advantage is the more effective protection it affords to men busy with repair or inspection. It is readily installed, is harmless if accidentally touched, and can be easily and safely connected and disconnected without the use of tools. *The inventor is entitled to reap the benefits of these advantages, although he may not have mentioned them, or even known of them, provided they come to light in operating the device actually described and claimed.*"

The correct rule is being followed in the Sixth Circuit Court of Appeals, as evidenced by the case of *Jackson Fence Co.* v. *Peerless Wire Fence Co.,* (C. C. A. 6, 1915), 228 F. 691, 696, where Judge Denison said:

"We do not overlook the fact that the peculiar utility which his invention is now seen to possess, and which we have described, is not stated in so many words in his specification; but there are two sufficient reasons why this omission is not important. The first is that if he had undertaken to state the practical, commercial benefits, and had omitted what afterwards proved to be the chief one, he would, nevertheless, be entitled to have his patent construed with reference to that unspoken advantage, since the patentee is entitled to the benefit of every function within the scope of the claims and actually possessed by his mechanism, even if he does not know of it at the time of patenting. *Morgan Co.* v. *Alliance Co.,* (C .C. A. 6) 176 Fed. 100, 107, 100 C. C. A. 30; *Kellogg* v. *Deane,* (C. C. A. 6), 182 Fed. 991, 998, 105 C. C. A. 545. The second reason is that

this patent does not undertake to name any practical advantages or benefits, save, in general terms, 'to simplify and improve upon the construction and apparatus of this class, whereby to enhance the practicability and commercial value thereof'; and *no obligation rests upon the patentee to convert his specification into a trade circular. Its proper office is to describe the structure, and in so far as the patentee claims commercial benefits and advantages, he is giving unnecessary information.*"

The holding of the Seventh Circuit Court of Appeals, in this case, is therefore directly opposite to the holding by this Honorable Court in *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.* (1911), 220 U. S. 428; and, unless certiorari is granted, the law in the Seventh Circuit will hereafter, in this regard, be in conflict with the law as laid down by this Court and as followed in the First, Third and Sixth Circuits.

The claims of the Johnson *et al.* patent do not attempt to define over the prior art by functional statements of advantages, and properly so. The claims define over the prior art by setting forth *definite physical characteristics,* such as that the dry pre-cooked cereal flakes are very thin and fragile, of porous construction throughout, characterized by dextrinization, etc. The cereal product *having these definite physical characteristics has the very important advantage,* for infant feeding, of an unexpectedly high liquid absorption ratio.

This advantage was completely disregarded by the Seventh Circuit Court of Appeals, on the basis of its erroneous proposition of law that an advantage not set forth in the claims is not to be given effect on the question of the presence of invention.

Conclusion.

We are here concerned with a really meritorious invention, one which not only constitutes a real advance in the art but which has been a boon (a very real blessing) to millions of mothers. It not only filled a long-felt want, a real need, but it received the praise of commercial success, petitioner's sales of Pablum rising at the rate of a million pounds a year, and it was immediately put into wide use by competitors of petitioner as soon as the merits of the Johnson *et al.* invention became known to the public.

A patent of this kind, covering a very real invention, should not be struck down merely because the lower courts have applied a rule of law which is inconsistent, not only with the law as announced by this court, but with the decisions of other courts of appeal. The public and industry generally are entitled to have this case decided in accordance with the well settled principles of law.

The action of the Seventh Circuit Court of Appeals in disregarding the advantage of an unexpectedly high water absorption ratio in the patented product, because that advantage was not described in the claims, is erroneous; and certiorari should be granted to correct this error.

Respectfully,

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